

DOI Code: AP.PRE.REQ

PTO/SB/33 (08-08)

Approved for use through 09/30/2008. OMB 0651-0031

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

089229.00007

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Name _____

Application Number:

10/018,502

Filed: February 25, 2002

First Named Inventor:

Kimmo NARKILAHTI

Art Unit: 2617

Examiner: Sharad K. RAMPURIA

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.


I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

- ☒ Attorney or agent of record.
Registration No. 52,738

- ☐ Attorney or agent acting under 37 CFR 1.34.
Registration Number if acting under 37 CFR 1.34 _____


SignatureBrad Y. Chin

Typed or printed name

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Telephone number

September 23, 2009

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 2649

Kimmo NARKILAHTI, *et al.*

Art Unit: 2617

Application No.: 10/018,502

Examiner: Sharad K. Rampuria

Filed: February 25, 2002

Attorney Dkt. No.: 089229.00007

For: METHOD AND SYSTEM FOR DETERMINING OPERATING MODES OF
USERS OF A TELECOMMUNICATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 23, 2009

Sir:

Applicants hereby submit this Pre-Appeal Brief Request for Review ("PABRR") of the twice rejected claims 1-24 in the above identified application. Claims 1-24 were first rejected in the Final Office Action dated August 14, 2008, based on Knight and Owensby. Applicants filed a PABRR on November 12, 2008, demonstrating that the rejections of claims 1-24 presented in the Final Office Action were in clear error. The Office issued a Notice of Panel Decision on May 11, 2009, reopening prosecution and withdrawing the Examiner's rejections of claims 1-24. The Office mailed a Non-Final Office Action dated June 24, 2009 ("Office Action"), rejecting claims 1-24 based on Knight and Kimoto. Accordingly, claims 1-24 have been twice rejected. A Notice of Appeal is timely filed herewith.

Applicants respectfully submit that the cited references fail to describe or suggest every element recited in claims 1-24, rendering the rejections clearly erroneous. The Office Action failed to demonstrate that Knight and Kimoto describe or suggest every

element recited in claims 1-24. Applicants respectfully submit that claims 1-24 are in condition for allowance.

The Office Action rejected claims 1-24 under 35 U.S.C. §103(a) as being allegedly unpatentable over Knight, *et al.* (United Kingdom Publication No. GB 2327175) (“Knight”) in view of Kimoto, *et al.* (U.S. Patent No. 6,115,611) (“Kimoto”). Applicants respectfully submit that the aforementioned claim rejections are in clear error, and therefore respectfully request withdrawal of the claim rejections for at least the reasons discussed below.

Clear Error: “filtering user-specific information corresponding to the defined at least one variable or the combination of variables from the information collected from the telecommunication system; and classifying the users of the telecommunication system based on the filtered user-specific information into various classes indicative of a user’s behavior patterns during use of the telecommunication system” is not disclosed in Knight or Kimoto.

Assuming *arguendo* that Knight could be combined with Kimoto, the combination of Knight and Kimoto fails to describe or suggest each and every element recited in claims 1, 13, and 19. Specifically, the combination of Knight and Kimoto fails to describe or suggest, at least, “filtering user-specific information corresponding to the defined at least one variable or the combination of variables from the information collected from the telecommunication system; and classifying the users of the telecommunication system based on the filtered user-specific information into various classes indicative of a user’s behavior patterns during use of the telecommunication system,” as recited in claim 1 (emphasis added).

Repeating the rejections presented in the Final Office Action dated August 14, 2008, the Office Action generally cited Knight at page 3, line 16, to page 4, line 6, and page 4, line 31, to page 5, line 34, to allege that Knight describes the step of filtering user-specific information recited in claim 1. Applicants respectfully disagree.

Knight merely describes *automatic downloading* of data according to predicted data requirements. A base station analyzes data associated with calls made by users of that station in order to form user usage profiles. The profiles are stored in a database, and then used to calculate or predict future usage. Based on those calculations, speculative connections are made available to specific users at presumably optimum times from the station's perspective in anticipation of demand. This is particularly applicable to data networks whereby users typically access data services at the same time each day. A change analyzer can determine a degree of change occurring in data pages, and can decide whether a whole page or just the modifications to the page should be sent to the subscriber. Call related data may include dialed call instructions, time of call, the location from which a call is dialed out/received, access to the Internet, and access to information services (Knight, page 3, line 16, to page 5, line 34).

Knight makes no mention of “filtering user-specific information corresponding to the defined at least one variable or the combination of variables from the information collected from the telecommunication system” (emphasis added). Accordingly, Applicants respectfully submit that Knight fails to describe or suggest any method or system which defines variables and filters user-specific information, as recited in claim 1. The Office Action failed to address each of these arguments presented in Applicants' PABRR.

As acknowledged in the Office Action, Knight fails to describe or suggest the step of classifying as recited in claim 1 (*see* Office Action on page 3). The Office Action alleged that Kimoto cures the deficiencies of Knight. In particular, the Office Action cited the division or hierarchization of information or services relating to position information of the mobile terminals 4 into two layers for information management, as described at column 44, lines 43-52, of Kimoto to allege that Kimoto describes the classifying step recited in claim 1. However, a review of these passages of Kimoto in relation to Kimoto in its entirety demonstrates that Kimoto fails to cure the deficiencies of Knight with respect to the classifying step recited in claim 1.

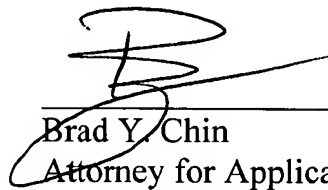
Claim 1 recites, in part, “classifying the users of the telecommunication system based on the filtered user-specific information into various classes indicative of a user’s behavior patterns during use of the telecommunication system” (emphasis added).

Kimoto merely describes the management of *information and services* related to position information of mobile terminals 4 within an information center 5, whereby the information and services may be transmitted to various mobile terminals 4 upon request (*see* Kimoto, col. 44, lines 43-65). Thus, contrary to the Office Action’s allegations, Kimoto makes no mention of “classifying the users of the telecommunication system based on the filtered user-specific information into various classes indicative of a user’s behavior patterns during use of the telecommunication system,” as recited in claim 1. Furthermore, Kimoto fails to describe the filtering step recited in claim 1, and therefore also fails to cure the deficiencies of Knight with respect to this limitation of claim 1. Accordingly, assuming *arguendo* that Knight could be combined with Kimoto, the combination of Knight and Kimoto fails to describe or suggest each and every element recited in claim 1.

Although the clear errors noted above are submitted with respect to the rejections presented for claim 1, the same clear errors exist with respect to each of the rejections of each of the claims. Accordingly, the Office Action’s rejections of claims 2-24 under 35 U.S.C. §103(a) based on Knight and Kimoto are in clear error for at least the reasons discussed above. Therefore, claims 2-24 should be in condition for allowance. Accordingly, these rejections should be summarily withdrawn. Therefore, Applicants respectfully submit that the aforementioned claim rejections are in clear error, and therefore respectfully request withdrawal of the claim rejections for at least the reasons discussed above.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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